

## **REMARKS**

The following remarks are submitted in response to the final Office Action mailed February 27, 2006, setting a three-month shortened statutory period for response ending May 27, 2006. Claims 1-11 and 13-35 remain pending in the Application. Claims 36 and 37 have been added. Reconsideration, examination and allowance of all pending claims are respectfully requested.

### **35 U.S.C. § 102 Rejections**

On pages 2-3 of the Office Action, the Examiner rejected claims 1-3, 9-11, 15, 20-22, 24-25, and 30-34 under 35 U.S.C. § 102(e) as being anticipated by *Renati et al.* (U.S. Patent Publication No. 2004/0044359).

Applicants respectfully assert that the *Renati et al.* reference cited by the Examiner does not disclose each and every limitation necessary to support an anticipation rejection of claims 1-3, 9-11, 15, 20-22, 24-25, and 30-34. The *Renati et al.* reference discloses a retrieval assembly (10) including a sheath (14) having a distal end (16) and a lumen (18). In one illustrative assembly (410) depicted in Figures 9-11, the sheath includes a tapering member (412) having a flexible distal tip portion (466). The distal tip portion (466), in turn, forms a filter housing portion (468) that can be configured to receive a filter (24) at least in part therein. As can be clearly seen in Figures 9-11, the wall thickness of the distal tip portion (466) does not increase in wall thickness, but instead tapers distally towards the distal end of the sheath. According to *Renati et al.*, the distal tip portion (466) imparts flexibility to the tapering member (412), allowing the distal tip portion (466) to shift between a first position and second position, as shown in Figures 9 and 10. In some cases, such flexibility may permit the distal tip portion (466)

to fold back proximally as the sheath (14) is advanced over the filter (24), as further shown in Figure 12.

In contrast to *Renati et al.*, independent claims 1, 15, and 24 each recite the limitation that at least a portion of the distal region (claims 1 and 15) or bulbous member (claim 24) of the elongate sheath has an increased wall thickness relative to adjacent portions of the distal region. Claim 1, for example, recites:

1. (Previously Presented) A device for use with an embolic protection filter, comprising:
  - an elongate sheath having a proximal region, a distal region, a lumen extending at least partially therethrough, and a distal mouth disposed adjacent the distal region;
  - wherein at least a portion of the distal region has an increased wall thickness relative to adjacent portions of the distal region;*
  - wherein the distal mouth is expandable and is adapted to shift between a basal configuration and an enlarged configuration; and
  - wherein the distal region includes a bulbous member in the basal configuration.

Such configuration can be clearly seen, for example, in Figure 5 of the present Application, which shows a bulbous region (326) of a retrieval sheath (310) having an increased wall thickness relative to adjacent portions of a distal region (324) of the sheath (310).

Unlike the devices and sheaths recited in independent claims 1, 15, and 24, the *Renati et al.* reference does not appear to disclose or suggest a distal or bulbous member of an elongate sheath having an increased wall thickness relative to adjacent portions of the distal region. To the contrary, and as discussed above, Figures 9-11 of *Renati et al.* appear to suggest a tapered configuration (*i.e.* a “tapering member”) in which the wall thickness of the shaft is decreased at the distal tip portion thereof. Thus, since the *Renati et al.* reference appears to suggest an opposite configuration from that recited in claims 1,

15, and 24, Applicants respectfully submit that these claims are allowable over *Renati et al.*

Because claims 1, 15, and 24 are allowable, dependent claims 2-3, 9-11, 20-22, 25, and 30-34 are also allowable for at least the reasons provided above, and since they claim other significant limitations not suggested by the cited prior art.

### **35 U.S.C. § 103 Rejections**

On page 3 of the Office Action, the Examiner rejected claims 4-8, 16-18, 23, and 26-28 under 35 U.S.C. § 103(a) as being unpatentable over *Renati et al.* (U.S. Patent Publication No. 2004/0044359) in view of *Johnson et al.* (U.S. Patent No. 6,596,011).

For reasons similar to that discussed above, Applicants respectfully submit that claims 4-8, 16-18, 23, and 26-28 are not obvious since the cited prior art references fail to disclose or suggest each and every element of those claims. As discussed previously, the *Renati et al.* reference does not appear to disclose a distal region or bulbous member of an elongate shaft having an increased wall thickness relative to adjacent portions of the distal region, as recited in each of independent claims 1, 15, and 24. The *Johnson et al.* reference similarly fails to disclose or suggest such feature. Accordingly, Applicants respectfully submit that dependent claims 4-8, 16-18, and 26-28 are not obvious in view of the cited prior art.

In addition, with respect to independent claim 23, Applicants further assert that neither *Renati et al.* nor *Johnson et al.* suggest a delivery and retrieval sheath wherein at least a portion of the distal region of an elongate tubular sheath has an increased wall thickness relative to adjacent portions of the distal region, as recited in that claim. Instead, and as set-forth above, *Renati et al.* appears to suggest an opposite configuration

wherein the wall thickness is decreased at a distal tip portion of the sheath. Consequently, Applicants submit that independent claim 23 is also not obvious in view of the cited prior art.

**Allowable Subject Matter**

On page 4 of the Office Action, the Examiner indicated that claims 14 and 35 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

As discussed previously, independent claims 1 and 24 each recite limitations not disclosed or suggested by the cited prior art, and are therefore allowable. Since claims 14 and 35 depend from these claims, Applicants submit that these claims are also allowable over the cited prior art.

Further, new claims 36 and 37 have been added. These claims include the limitations of claims 1 and 14, and 24 and 35 respectively.

Reexamination and reconsideration are requested. It is respectfully submitted that all pending claims are now in condition for allowance. Issuance of a Notice of Allowance in due course is also respectfully requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

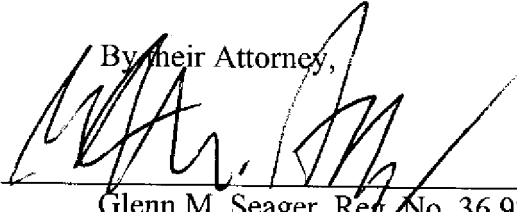
Respectfully submitted,

BRIAN J. LOWE ET AL.

By their Attorney,

Date:

April 27, 2006

A handwritten signature in black ink, appearing to read "Glenn M. Seager", written over a horizontal line.

Glenn M. Seager, Reg. No. 36,926  
CROMPTON, SEAGER & TUFTE, LLC  
1221 Nicollet Avenue, Suite 800  
Minneapolis, Minnesota 55403-2420  
Tel: (612) 677-9050